

REMARKS/ARGUMENTS

Overview

The Examiner responded in the prior Office Action as follows: rejected claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by Ronen (U.S. Patent No. 5,745,556), and rejected claims 6-18 under 35 U.S.C. § 103(a) as being unpatentable over Ronen in view of Nolting (U.S. Patent No. 6,351,453).

Applicant hereby amends claims 6 and 10-14 in order to clarify the subject matter of their invention. Applicant further hereby cancels claims 1-5 in order to simplify outstanding issues and expedite issuance of a patent. Thus, claims 6-18 are now pending.

Embodiments of the Present Invention

Embodiments of the present invention are directed to assisting with the placement of a telephone call by a user via a modem, such as a modem in a shared modem pool that is accessible over a network by users of that network. In some embodiments, the disclosed techniques are used to restrict the ability of users to place outgoing phone calls over a modem so that only authorized users of the network are allowed to place such calls, thus ensuring that billing of the appropriate user can be accomplished. For example, in some embodiments after receiving a request from a user of a network to place a call via one of the modems of a shared modem pool but before placing the call, the user is authenticated as a valid user of the network and authorized to place the call based on identifying information for that user. If the user is determined to be authorized, the call is then placed, and the user identifying information is used to bill the user for the telephone call that they placed.

The Ronen Reference

Ronen is directed to techniques for an ISP (Information Service Provider) to bill users for information and/or interactive services. In particular, a user first places a call to a 900 telephone number that is associated with the ISP, or the user can instead place a call to the ISP and the ISP can notify the telephone company of the 900

telephone call. The telephone company then charges the user for the telephone call in the normal manner as for any telephone call with a toll charge, and provides payment to the ISP based on the charges to the user.

The Nolting Reference

Nolting is directed to techniques for a telephone network to identify users who are heavy users of network resources, such as ISPs with modem pools that receive numerous calls from their subscribers. Nolting appears to be unrelated to controlling access to which users can place outgoing phone calls and to authenticating a user as an authorized network user based on identifying information about the user, and in particular does not perform such authentication before allowing a telephone call for the user to be placed via a modem.

Analysis

The Examiner has rejected claims 1-5 as being anticipated by Ronen. While Applicant disagrees that claims 1-5 are anticipated by or obvious in light of Ronen, these claims have been canceled to simplify outstanding issues. Thus, the rejection of these claims is mooted.

The Examiner has rejected each of the other previously pending claims 6-18 as being unpatentable over Ronen in view of Nolting. However, each of the previously pending claims as rejected included features and provided functionality not disclosed by Ronen or Nolting, and are thus each allowable.

One example of why the previously pending claims are allowable over Ronen and Nolting relates to the inventive techniques of, in at least some embodiments, restricting the ability of users to place outgoing phone calls over a modem so that only authorized users of the network are allowed to place such calls, thus ensuring that billing of the appropriate user can be accomplished. For example, independent claim 15 as rejected recites "receiving a request from a user of the network to place a telephone call via a shared modem pool having multiple modems", "receiving user identifying information to authenticate the request as coming from a valid user of the

network”, and “if the user identifying information received is authenticated, correlating the user identifying information with billing information associated with the user; placing the telephone call via one of the modems of the shared modem pool; and billing the user for the call”. Independent claims 6 and 10 as amended recite similar language.

Conversely, the Examiner has pointed to no teaching or suggestion in either Ronen or Nolting that is related to the inventive techniques recited in the pending independent claims, in part because these references are directed to different goals. For example, Ronen would have no motivation to include the recited authentication of users prior to allowing outgoing calls to be placed in order to allow corresponding billing of the users, as Ronen is expressly directed to situations in which there is no such defined relationship between a user and an ISP (“[a]n object of the present invention is to provide a payment mechanism for a user to access an ISP . . . which does not require . . . the establishment of a financial relationship between the user and the ISP” - Ronen, 1:44-48). More generally, the Examiner has pointed to no teaching or suggestion in Ronen that is related to controlling access to outgoing phone calls over a modem for any purpose, or to any notion of authenticating users for that or any other purpose – instead, Ronen teaches that *after a user completes a call* to a 900 number, whether directly or via an ISP to whom a call from the user has been completed, that standard telephone billing mechanism for 900 numbers is used to bill the user. Thus, not only does there appear to be no controlling of access to placing outgoing calls in the cited sections of Ronen, there is no notion of authenticating users or of the system that places the outgoing calls using stored billing information for such authenticated users to bill them.

In addition, Nolting does not correct these deficits of Ronen with regard to the various recited inventive features of the pending claims. Instead, the cited passages of Nolting are expressly related to situations in which *users place calls to ISPs that are received at the ISP via a modem pool of the ISP* (“the user activates her PC and modem to dial a number for the ISP” and the “telephone network switches the call through to a line going to a modem pool operated by the ISP” – Nolting, 2:46-49). In a similar manner to Ronen, the cited passages are unrelated to controlling of access to

placing any type of outgoing calls, and there is no notion of authenticating users or of the system placing the outgoing calls using stored billing information for such authenticated users to bill them.

Moreover, even in *Nolting* had corrected these deficits of *Ronen* with regard to the recited inventive techniques, *Ronen*'s teaching away from use of its techniques in situations with any predefined relationships with users would negate any motivation to combine these two references. The only cited motivation to combine these references is that the combination would allegedly provide the recited inventive techniques, which is based on hindsight reconstruction using Applicant's disclosure. The Examiner is reminded that, according to the Manual of Patent Examining Procedure ("MPEP") and controlling caselaw, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, and instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two prior art references.¹ The MPEP provides similar instructions.²

1

The *Nortrup* reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the *Nortrup* display does not include a demonstration of how to adjust the functions. The *Thunderchopper Handbook* describes the *Thunderchopper* game's video display as having a "demonstration mode" showing how to play the game . . . Lee appealed to the Board, arguing that . . . the prior art provided no teaching or motivation or suggestion to combine this reference [*Thunderchopper*] with *Nortrup* . . . On the matter of motivation to combine the *Nortrup* and *Thunderchopper* references, . . . review of the Examiner's Answer reveals that the examiner merely stated that both the *Nortrup* function menu and the *Thunderchopper* demonstration mode are program features and that the *Thunderchopper* mode "is user-friendly" and it functions as a tutorial, and that it would have been obvious to combine them.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Conversely, and in a similar manner to the arguments rejected by the Federal Circuit, the Examiner's motivation to combine these two prior art references is based solely on the alleged beneficial results that would result from combining them, with no motivation from the prior art cited to support the combination. Thus, if the Examiner maintains the current rejection on the basis of the above reasoning, Applicant requests that the Examiner explain with the required specificity where the Examiner finds a suggestion or motivation in the references for this combination.

The pending dependent claims include the features of those claims from which they depend, and are thus allowable for the same reasons as those claims. Moreover, the pending dependent claims also recite additional features lacking in the cited references, and are thus allowable on the basis of those features as well, although those various features are not enumerated here for the sake of brevity.

See, e.g., . . . In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . .

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements . . . do not adequately address the issue of motivation to combine.
In re Sang-Su Lee, 277 F.3d 1338, (Fed. Cir. 2002).

2

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).


Manual of Patent Examining Procedure, § 2143 (emphasis added).

Conclusion

In light of the above remarks, Applicant respectfully submits that all of the pending claims are allowable. Applicant therefore respectfully requests the Examiner to reconsider this application and timely allow all pending claims. Moreover, if the Examiner believes that it will expedite resolution of any outstanding issues, Applicant encourage the Examiner to contact the Applicant's representative at (206) 264-6380.

Respectfully submitted,
Perkins Coie LLP

Date: 3/31/03


James A. D. White
Registration No. 43,985

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888

Appl. No. 09/665,780

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

6. (Twice Amended) A method of processing a request through a network to place a telephone call via a modem ~~through a network~~, comprising the steps of:

receiving user identifying information associated with a user that has made the request through the network to ~~placed a~~ the telephone call via a modem pool; ~~the telephone call placed through the network;~~

before placing the telephone call via the modem, searching a database containing information related to users of the network to correlate the user identifying information with the user and to authenticate the user as a valid user of the network; and

if the user is authenticated as a valid user of the network,

_____ forwarding call charge information from a public telephony network so that the user is billed for the call; and

_____ placing the telephone call via the modem. ~~passing the telephone call through the network if the user identifying information has been correlated to the user and the user has been authenticated as a valid user of the network.~~

10. (Twice Amended) A computer system network ~~that~~ utilizes a modem for processing calls made through ~~the~~ a network, comprising:

a server ~~for~~ able to ~~receive~~ing user identifying information associated with a user of the network that has requested to ~~placed~~ a telephone call via a shared modem pool and able to, after the user has been authenticated as a valid user of the network, place the telephone call via the shared modem pool;

a search module ~~for~~ able to ~~searching~~ a database containing information related to users of the network ~~and for in order to~~ correlateing the user identifying information with the user ~~to~~ and authenticate the user as a valid user of the network and able to

~~notify the server of authentication of the user such that when the user has been authenticated as a valid user of the network, the telephone call is passed through the network; and~~

a billing aggregator module, ~~which~~ able to aggregates charge call information received ~~form~~ from a public telephony network and the user identifying information so that the user is billed for the call.

11. (Amended) The computer system network ~~recited~~ in claim 10, further comprising a correlating module for comparing the user identifying information with records of user billing information stored in the database.

12. (Amended) The computer system network ~~recited~~ in claim 11, further comprising a billing module in communication with the correlating module for billing the user for the telephone call when the user has been authenticated as a valid user of the network.

13. (Twice Amended) The computer system network ~~recited~~ in claim 12, wherein the network comprises a wireless network.

14. (Amended) The computer system network ~~recited~~ in claim 10, further comprising a shared modem pool with multiple modems that is accessible over the network to each of multiple users of the network.